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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBENDRA DAS SHARMA

Appeal 2009-000030
Application 10/011,857
Technology Center 2100

Decided:¹ May 29, 2009

*Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, Administrative Patent Judges.*

HUGHES, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We AFFIRM-IN-PART.

Appellants' Invention

Appellant invented a system and method for controlling the flow of ordered pipelined instructions (transactions) between a first electronic device (producing node) and a second electronic device (consumer node). An electronic information exchange (communications) medium (e.g., a bus) and optional intervening forwarding nodes interconnect the producing node and the consumer node. The electronic communications medium includes a communications protocol for transmitting transaction requests and for returning responses (replies) among the nodes (e.g., transmitting acceptance ("ACK") and non-acceptance ("NAK") replies indicating the status of the transaction requests). (Spec. 1, l. 6 to 3, l. 27.)²

² We refer to Appellant's: Specification ("Spec."); Declaration under 37 C.F.R. § 1.131 filed August 10, 2004 ("Decl."); Appeal Brief ("App. Br.") dated January 26, 2006; Reply Brief ("Reply Br.") dated May 30, 2006, and Supplemental Appeal Brief ("Supp. App. Br.") dated September 27, 2007 (entitled "Reply Brief" by Appellant). We also refer to the Examiner's Answer ("Ans.") mailed July 25, 2007.

Claims

Independent claim 1 illustrates the invention and reads as follows:

1. A method for controlling flow of requests and replies between a first electronic device that stores new and pending requests in an electronic memory and retrieves new and pending requests from the electronic memory for transmission, and a second electronic device that accepts requests transmitted from the first electronic device, transmitting back to the first electronic device an ACK reply, and rejects requests transmitted from the first electronic device, transmitting back to the first electronic device a NAK reply, the method comprising:

storing by the first electronic device a retry bit associated with each stored request;

storing by the second electronic device a retry vector containing bits corresponding to a first set of electronic devices from which the second electronic device receives requests;

maintaining a copy in storage, by the first electronic device, of each request until an ACK reply corresponding to the request is received by the second electronic device;

employing the retry bits associated with each stored request by the first electronic device to mark requests for retransmission; and

employing the retry vector by the second electronic device to mark a second set of electronic devices that need to retransmit one or more rejected requests.

Reference

The Examiner relies on the following reference as evidence in support of the anticipation rejection:

Uehara US 2002/0040414 A1 Apr. 4, 2002
(Filed Jul. 3, 2001)

Rejections

The Examiner rejects claims 1 and 4-15 under 35 U.S.C. § 102(e) as being anticipated by Uehara.

The Examiner also rejects claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Appellant's Contentions

Appellant contends that the Examiner improperly rejected the claims. Appellant asserts that Uehara is not a proper § 102(e) reference because Appellant conceived of the invention prior to the effective date of Uehara and acted with due diligence to reduce the invention to practice. (Supp. App. Br. 7-8.) Appellant also asserts that claims 1-20 are not indefinite (under 35 U.S.C. § 112, second paragraph). (Supp. App. Br. 12.)

Examiner's Findings and Conclusions

The Examiner found that Uehara discloses each feature of Appellant's claimed invention. (Ans. 6-8.) The Examiner also found that Uehara was a proper § 102(e) reference, and that Appellant's § 1.131 declaration was insufficient to prove conception and diligent reduction to practice to "swear behind" Uehara's effective date. (Ans. 8-14.) The Examiner further found that Appellant's claims 1-20 were indefinite. (Ans. 4-5.)

ISSUES

1. Did Appellant establish that the Examiner erred in finding that Appellant's § 1.131 declaration was insufficient to antedate the effective date of the Uehara reference?
2. Did Appellants establish that the Examiner erred in concluding that claims 1-20 are indefinite?

FINDINGS OF FACT (FF)

We find that the following enumerated findings are relevant to the rejections under review and are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Appellants' Invention

1. Appellant invented a system and method for controlling the flow of transactions between a first electronic device and a second electronic device through an electronic communications medium and optional intervening forwarding nodes that interconnect the first and the second electronic devices. The electronic communications medium includes a communications protocol for transmitting transaction requests and for returning replies indicating the status of the transaction requests. (Spec. 1, 1. 6 to 3, l. 27.)

2. Claim 1 of Appellant's invention recites a first electronic device, a second electronic device, a first set of electronic devices, and a second set of electronic devices. (App. Br. 14; Supp. App. Br. 19.)

3. Each of Appellant's claim 1 terms – a first electronic device, a second electronic device, a first set of electronic devices, and a second set of electronic devices – are modified by the article "a." Proper antecedent basis exists within claim 1 for each of these claim terms. (App. Br. 14; Supp. App. Br. 19.)

4. Claim 13 of Appellant's invention recites an electronic device. (App. Br. 16.)

5. Appellant's electronic device term is modified by the article "an." Proper antecedent basis exists for this claim term. (App. Br. 16.)

6. Claim 15 of Appellant's invention recites as set of electronic devices. (App. Br. 16.)

7. Appellant's electronic device term is modified by the article "a." Proper antecedent basis exists for this claim term. (App. Br. 16.)

Appellant's § 1.131 Declaration

8. Appellant's filed the Declaration ("Declaration of Prior Invention" under 37 C.F.R. § 1.131) on August 10, 2004. (Decl. 1.)

9. The Declaration comprises nine pages, includes a copy of a three-page Invention Disclosure document, dated June 11, 2001, and executed by Appellant. (Decl. 5-7.)

10. The Invention Disclosure document includes a three-paragraph description of the invention. (Decl. 7.) The Declaration also includes a one-sentence statement regarding diligence in reduction to practice of the invention. (Decl. 8.)

11. The Invention Disclosure document discusses ordered transactions, a source node, a destination node, a retry bit and a retry bit vector. (Decl. 7.) The Invention Disclosure Document also provides an overview of the retry bit vector operation. (Decl. 7.)

12. Appellant's Declaration does not discuss, for example, storing new and pending requests in an electronic memory, retrieving new and pending requests from the memory for transmission; accepting requests transmitted from an electronic device in a different electronic device, and transmitting back to the first electronic device an ACK reply; receiving and rejecting requests transmitted from an electronic device, and transmitting back to the first electronic device a NAK reply; the described retry bit being associated with each stored request, and storing the retry bit in a first electronic device; or maintaining a stored of each request in a first electronic

device until an ACK reply corresponding to the request is received. (Decl. 7; Supp. App. Br. 19 (claim 1).)

13. Appellant's Declaration provides two brief statements regarding diligence in reducing the invention to practice. The Declaration states that: (a) “[a]ttached is a statement establishing the diligence of the applicants, from the time of their conception, to a time just prior to the date of the reference, up to the . . . filing of this application;” and (b) “I hereby provide an Invention Disclosure, which establish [sic] conception of the invention claimed in claims 1-20 of the above-identified patent application and a reduction to practice of an embodiment of the invention prior to the filing date of the cited reference (July 3, 2001).” (Decl. 3, 8.) We find that the Declaration provides no additional evidence or documentation of the purported diligence.

PRINCIPLES OF LAW

Burden on Appeal

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Indefiniteness

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). During prosecution, claims need not be “insolubly ambiguous” to

be considered indefinite under 35 U.S.C. § 112, second paragraph. *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

Declaration Under 37 C.F.R. § 1.131

The Board evaluates a declaration submitted pursuant to 37 C.F.R. § 1.131 on its merits, considering the evidence relied upon in light of the arguments explaining why the evidence is sufficient. The Board has broad discretion in weighing declaration evidence. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004); *In re Inland Steel, Co.*, 265 F.3d 1354, 1366 (Fed. Cir. 2001).

An Applicant's declaration must clearly explain the evidence and exhibits, pointing out exactly what facts are established and relied on by applicant to show conception and reduction of the invention to a practical form:

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b).

MPEP § 715.07 (I) (quoting *In re Borkowski*, 505 F.2d 713, 718 (CCPA 1974)). *See also In re Harry*, 333 F.2d 920, 922 (CCPA 1964) (Where the affidavit "asserts that facts exist but does not tell what they are or when they occurred."). A declaration exhibit need not support all claimed limitations; however, any missing limitation must supported by the declaration itself.

MPEP § 715.07 (I) (citing *Ex parte Ovshinsky*, 10 USPQ2d 1075 (BPAI 1989)).

ANALYSIS

Rejection of claims 1 and 4-15 under 35 U.S.C. § 102(e)

The Examiner rejects claims 1 and 4-15 under 35 U.S.C. § 102(e) as being anticipated by Uehara. Appellant contends that Uehara is not a proper § 102(e) reference. (Supp. App. Br. 7-8.) Specifically, Appellant attempts to “swear behind” Uehara, by providing a declaration under 37 C.F.R. § 1.131. Appellant contends the declaration “establishes conception of the invention prior to the effective date of the reference coupled with due diligence from the prior effective date.” (Supp. App. Br. 8.) The Examiner, however, finds Appellant’s declaration is defective, and thus Uehara is a proper reference that discloses each feature of Appellant’s claims (Ans. 6-14). We will affirm the Examiner’s rejection of claims 1 and 4-15 for the reasons that follow.

We initially note that Appellant does not address the merits of the Examiner’s anticipation rejection, instead focusing solely on whether Uehara is prior art. (App. Br. 6-9; Supp. App. Br. 7-12.) Accordingly, we address only the issues on appeal before us as presented by Appellant in the Briefs and do not reach the merits of the Examiner’s anticipation rejection. Arguments that Appellant could have made but chose not to make in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). Additionally, Appellant appears to assert that the Examiner committed “clear error” in declining to enter Appellant’s final amendment and new declaration under 37 C.F.R. §

1.131. (Supp. App. Br. 8, 11.) We note that “[r]eview of an examiner’s refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences.” MPEP § 715.09 (citing *In re Deters*, 515 F.2d 1152 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941)). And, we must carefully observe the “line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director)” MPEP § 1201. Accordingly, we do not address the Examiner’s non-entry of Appellant’s second § 1.131 declaration.

Appellant concedes that he did not reduce the invention to practice prior to Uehara’s effective date. Rather, Appellant presents the § 1.131 declaration to show “the conception of the invention by Appellant prior to the date of the cited reference and diligence in pursuing a constructive reduction to practice.” (Supp. App. Br. 7-8.) Accordingly, Appellant’s declaration must demonstrate just that – “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application.” MPEP § 715.07(III)(C).

Conception

Conception is “the complete performance of the mental part of the inventive act” and it is “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice.” *Townsend v. Smith*, 36 F.2d 292, 295 (CCPA 1929). *See Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d

1367, 1376 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”). The conception of an invention “is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Int. 1973). See *Gunter v. Stream*, 573 F.2d 77 (CCPA 1978) (Conception may be established by the disclosure of an invention enabling one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.”) See also *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) (“It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception.”). Thus, in order to prove prior conception, Appellant’s declaration must demonstrate – with a showing of facts (evidence) of sufficient character and weight – that Appellant was in possession of each limitation recited in the appealed claims at the time of alleged conception. We have broad discretion in weighing such declaration evidence. *In re Am. Acad. of Sci.Tech Ctr.*, 367 F.3d at 1368.

We agree with the Examiner that Appellant’s declaration does not provide factual evidence demonstrating that Appellant was in possession of each limitation recited in the appealed claims at the time of alleged conception. (Ans. 10, 13-14.) Appellant’s declaration includes an Invention Disclosure document that was executed prior Uehara’s effective date (July 3,

2001). (FF 8, 9.) The Invention Disclosure document includes a brief, three-paragraph discussion of the invention and its operation. (FF 10.) The Invention Disclosure document discusses ordered transactions, a source node, a destination node, a retry bit, a retry bit vector, and an overview of the retry bit vector operation. (FF 11.) The declaration, however, does not address numerous other limitations recited in the appealed claims. (FF 12.) For example, with respect to claim 1, we find the declaration does not explain or mention, much less show possession of: (1) a first electronic device that stores new and pending requests in an electronic memory and retrieves new and pending requests from the electronic memory for transmission; (2) a second electronic device that accepts requests transmitted from the first electronic device, transmitting back to the first electronic device an ACK reply, and rejects requests transmitted from the first electronic device, transmitting back to the first electronic device a NAK reply; (3) storing by the first electronic device a retry bit associated with each stored request; or (4) maintaining a copy in storage, by the first electronic device, of each request until an ACK reply corresponding to the request is received by the second electronic device. (FF 12.)

While Appellant is correct that the Invention Disclosure document in the declaration need not disclose each claim limitation, and “must be evaluated with respect to what it discloses, in view of the level of knowledge of one ordinarily skilled in the art and the extensive information available in textbooks and online at the time” (Supp. App. Br. 12.) We do not agree with Appellant that

anyone conversant with computer science, cursorily familiar with hardware design, and having the ability to access online

information through the Internet and printed information resources, including textbooks, could understand the disclosed invention and complete a description equivalent to that of the current application using the invention disclosure provided by Appellant and included in Exhibit I.

(Supp. App. Br. 11.) To the contrary, we find that Appellant's declaration does not even discuss the differences between the claimed invention and the Invention Disclosure document. While a declaration exhibit need not support all claimed limitations, any missing limitation must be supported by the declaration. *Ex parte Ovshinsky*, 10 USPQ2d 1075. Accordingly, Appellant has not demonstrated conception of the above-described features by showing that the differences between the claimed invention and the Invention Disclosure document in the declaration would have been obvious to one of ordinary skill in the art, in view of the Invention Disclosure document evidence, prior to the effective date of the Uehara reference. Moreover, we find Appellant has failed to provide a clear explanation of the Invention Disclosure document in the Declaration that points out exactly what facts are established and relied on by Appellant. See *In re Harry*, 333 F.2d at 922; *In re Borkowski*, 505 F.2d at 718-19. Accordingly, we find Appellant's declaration insufficient to show prior conception of the invention of the appealed claims.

Reduction to Practice

Where conception of a claimed invention occurs prior to the effective date of prior art reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Rather, applicant must show evidence of facts establishing diligence. MPEP

§§ 715.07(I), 715.07(a) (citing *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889)). *See also In re Harry*, 333 F.2d at 922; *In re Borkowski*, 505 F.2d at 718-19. While Appellant asserts that he was diligent in reducing the invention to practice (Supp. App. Br. 8), we find that Appellant did not provide any evidence of diligence in the Declaration. (FF 10, 13.) Instead, Appellant provides a single sentence statement that the invention was reduced to practice – the Invention Disclosure establishes “a reduction to practice of an embodiment of the invention prior to the filing date of the cited reference (July 3, 2001).” (FF 10, 13.) Appellant’s assertion that the Declaration demonstrates a reduction to practice amounts to a mere pleading that is unsupported by proof or a showing of facts and, as such, does not satisfy the requirements of 37 C.F.R. § 1.131(b). *See In re Borkowski*, 505 F.2d at 718. Thus, we find Appellant’s declaration insufficient to show diligent reduction of the invention of the appealed claims to a practical form or constructive reduction to practice by filing of the present patent application.³ Accordingly, we find that the Examiner correctly determined Uehara was a proper § 102(e) reference, and Appellant’s § 1.131 declaration was insufficient to prove conception and diligent reduction to practice – Appellant provides no persuasive evidence supporting his assertions to the contrary.

³ In determining the sufficiency of a § 1.131 declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 117 USPQ 455 (Bd. App. 1958). As set forth previously, Appellant does not establish prior conception. Even so, here we address the diligence requirement in view of Appellant’s arguments.

*Rejection of claims 1-20 under 35 U.S.C. § 112,
Second Paragraph*

The Examiner rejects claims 1-20 for being indefinite for failing to particularly point out and distinctly claim the invention. Appellant contends that all the claimed limitations are clear and include proper antecedent basis. (Supp. App. Br. 12-16.) The Examiner, conversely, has determined that certain claimed limitations are indefinite. (Ans. 4-5). We will reverse the Examiner's rejection of claims 1-20 for the reasons that follow.

Claim 1, and dependent claims 2-14, recite "a first set of electronic devices" and "a second set of electronic devices." (FF 2.) The Examiner asserts that the first set and second set (of electronic devices) lack antecedent basis. (Ans. 5.) We find that "a first set of electronic devices" and "a second set of electronic devices" are modified by the article "a," and that proper antecedent basis exists for these claim terms. (FF 3.) We note that "the failure to provide explicit antecedent basis for terms does not always render a claim indefinite." MPEP § 2173.05(e). Here, the claim terms in question have proper antecedent basis, and appear in claim 1 in a way which would permit the one of skill in the art to determine the meaning of the terms.

The Examiner rejects claim 9 because "the word 'directly' is unclear." (Ans. 5.) Claim 9 recites that "the first electronic device is directly connected to the second electronic device by an electronic communications medium." The Examiner appears to construe the claim such that the first and second electronic devices must be physically directly connected. (Ans. 5, 15.) Appellant argues for a broader construction consistent with the

specification. (Supp. App. Br. 14.) We agree with Appellant that “directly connected” means “directly connected through a single communications medium.” (Supp. App. Br. 14.) The term directly is not unclear.

The Examiner rejects claims 11 because the term “a number of electronic communication media” is unclear and because Appellant omits “the essential structural cooperative relationship” among the communications media and the forwarding nodes. (Ans. 5.) Appellant explains that a producing node (first electronic device) and consuming node (second electronic device) may be indirectly interconnected through a number of electronic communication media (“such as busses and signal lines”) and additional forwarding nodes. (Supp. App. Br. 14.) We find Appellant’s explanation persuasive, and agree with Appellant that the term – a number of electronic communication media – is not unclear. We also find that the Examiner’s rejection based on MPEP § 2172.01 is inappropriate. The Examiner fails to explain how or where Appellant has stated that the claim scope does not correspond with that which Appellant regards as the invention – “the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention.” MPEP § 2172(I) (citing *In re Moore*, 439 F.2d 1232 (CCPA 1971)). Section 112, paragraph 2 does not require an applicant to set out each and every “structural cooperative relationship” in a claim, only that the scope of an applicant’s claim is clear, so that the public is informed of the boundaries of what constitutes infringement of the claim.

The Examiner rejects claim 13 because the term “an electronic device” is unclear. (Ans. 5.) Claim 13 recites that “each bit of the retry

vector corresponds to an electronic device, directly connected to the second electronic device.” The Examiner appears to construe “an electronic device” in claim 13 as either the first or second electronic devices of claim 1. (Ans. 5, 17.) Appellant explains that the bits correspond to the multiple devices that may connect and send requests to the second electronic device. (App. Br. 10-11.) We find Appellant’s argument persuasive. Also, Appellant’s “electronic device” term is modified by the article “an.” We find that proper antecedent basis exists for this claim term. (FF 4, 5.) Thus, we agree with Appellant that an “electronic device” in claim 13 is not unclear.

The Examiner rejects claims 15 because the term “a set of electronic devices” is unclear and lacks antecedent basis, and because Appellant omits “the essential structural cooperative relationship” between the first and second electronic devices. (Ans. 5.) Claim 15 recites “a retry vector . . . containing retry vector bits corresponding to a set of electronic devices from which the second electronic device receives requests.” (FF 6.) As with claim 13, Appellant explains that the bits correspond to the multiple devices that may connect and send requests to the second electronic device. (App. Br. 10-11.) Also, Appellant explains the interconnection between the first and second electronic devices. (Supp. App. Br. 14-15.) We find Appellant’s explanations persuasive, and agree with Appellant that the term – a set of electronic devices – is not unclear. We also agree with Appellant that the claim does not omit any essential structural cooperative relationship between the first and second electronic devices. As with claim 1, we find that “a set of electronic devices” is modified by the article “a,” and that proper antecedent basis exists the claim term. (FF 7.) Thus, for all the reasons set

forth *supra*, we conclude that claims 1-20 particularly point out and distinctly claim the Appellant's invention, and the claims are not indefinite under 35 U.S.C. § 112, second paragraph. Appellant has established that the Examiner erred in determining that claims 1-20 are indefinite.

CONCLUSIONS

On the record before us, Appellant has not established that the Examiner erred in finding that Appellant's § 1.131 declaration was insufficient to antedate the effective date of the Uehara reference.

However, Appellant has established that the Examiner erred in determining that claims 1-20 are indefinite under 35 U.S.C. §112, second paragraph.

DECISION

We affirm the Examiner's rejection of claims 1, and 4-15 under § 102(e). We reverse the Examiner's rejection of claims 1-20 under §112, second paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

Appeal 2009-000030
Application 10/011,857

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